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Response to Office Action of 13 June 2003

Atty Docket 115699.00077

Remarks1) Summary of Prosecution to Date

This letter is responsive to the Examiner's Office Action of June 13, 2003. At the time of that office action claims 1 - 7, 13 - 21, 24, 28, 29, 32 - 34, 41 - 54, and 57 - 83 were pending in the case. The Office Action indicated that

- (a) Claims 28, 29 and 32 - 34 are allowed;
- (b) Claims 4, 5, 7, 14 - 19, 62, 65 and 73 - 77 are objected to, but would be allowed if re-written in independent form;
- (c) Claims 13, 20, and 41 - 45 are rejected under 35 USC 112;
- (d) Claims 28, 29, 32 - 34 and 41 - 45 "stand allowable";
- (e) Claims 1 - 3, 6, 20 - 21, 24, 46 - 47, 58, 66 - 68 and 72 are rejected under 35 USC 102 (b) as being anticipated by US Patent 3,371,622 of Lich;
- (f) Claims 48, 49, 51 - 52, 57, 59 - 61, 63 - 64, 69 - 71, 78 - 79, and 81 - 83 are rejected under 35 USC 103 as being obvious given US Patent 3,371,622 of Lich in view of US Patent 5,622,115 of Ehrlich et al.

2) Formalities Under 35 USC 112Claim 13

The applicant thanks the Examiner for identifying the typographical error in claim 13. The claim has been amended to change "second" to "first" in the second occurrence, as should originally have been indicated.

Claim 20

Claim 20 was inadvertently identified as being dependent upon claim 6. This has now been corrected by amendment to show a dependency from claim 19.

Claims 41 - 45

Claims 41 - 45 have been indicated both as presently standing allowable (page 8, paragraph 10) and as being rejected under 35 USC 112. This is somewhat confusing to the applicant. The applicant would appreciate clarification on this point, and, in the event that claims 41 - 45 really are rejected under 35 USC 112, the applicant respectfully requests a non-final opportunity in which to respond to the rejection.

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In any case, the applicant respectfully submits that claims 41 - 45 are correctly drafted as they presently stand. The wording that the Examiner appears to find confusing has been discussed previously, and, the explanation formerly given remains correct. To the extent that this may remain unclear, the Examiner may wish to speak with the applicant's agent by telephone to review the grammatical structure of the sentence. In brief, there is no antecedent relationship between the first, second, and third trucks (nouns modified by express adjectives "first", "second" and "third") and the term that the rail road unit can be "free of trucks" (an inherently adjectival condition related to the car unit body to which it applies).

3) 35 U.S.C. 102 - Test for Anticipation

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, mbH. v. Dart Industries, Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

4) 35 U.S.C. 103 - Obviousness

(a) MPEP Section 2142: Basic Requirements of a Prima Facie Case of Obviousness

Section 2142 of the Manual of Patent Examining Procedure (MPEP) states:

ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the

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applicant's disclosure. *In re Vaack*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(b) Mere Possibility of Combination is Not Sufficient

Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) states:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

(c) Must Have Teaching, Suggestion, or Incentive to Combine

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention *absent some teaching, suggestion or incentive* supporting the combination *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir.). Cited in *In re Geiger*, 815 F.2d at 688, 2 USPQ 2d at 1268 (Fed. Cir. 1987) (Emphasis added). See also *In re Lee*, (61 USPQ 2d 1430 (CAFC, 2002)).

Obviousness cannot be established by combining references without also providing objective evidence of the motivating force that would impel one skilled in the art to do what the patent applicant has done (See *In Re Lee, infra* ; see also *Ex Parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993)).

(d) Inquiry Must Present a Convincing Line of Reasoning

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed toward obvious subject matter, either the references must expressly or impliedly, suggest the claimed invention or *the examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex Parte Clapp*, 227 USPQ972, 973 (Bd. Pat. App. & Inter. 1985) (Emphasis added).

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex Parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)."

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(c) Inquiry Must Be Thorough And Searching

"The factual enquiry whether to combine the references must be thorough and searching. Id., It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. ...

"The need for specificity pervades this authority. See e.g.:

In re Kotzab 217 F. 3d 1365, 1371, 55 USPQ 2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.");

In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.");

In re Iritch, 972 F. 2d 1260, 1265, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) (The examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references")."

(*In re Lee*, 61 USPQ 2d 1430 (CAFC, 2002). Emphasis and paragraph division added.)

Conclusory statements by an examiner do not adequately address the issue of motivation to combine. (*In re Lee*, *supra*).

(f) "Would have been obvious to one skilled in the art"

The MPEP requires that the examiner provide an objective source of support for a contention that a feature is known or obvious to one skilled in the art. An unsupported statement that a feature or combination "would have been obvious to one skilled in the art" is improper if made without support. *In re Lee*, *supra*, and *In re Garrett* 33 BNA PTCJ 43.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention

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was made because references relied upon teach that all aspects of the claimed invention were individually known in the art" is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). See also *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). (The level of skill in the art cannot be relied upon to provide suggestion to combine references).

(g) Destruction of Function

"If proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

(h) "Obvious to one of ordinary skill in the art"

In several instances the Examiner has suggested that modifications are "obvious to one of ordinary skill in the art". The applicant respectfully traverses each and every such instance. As noted in *In Re Lee* and *Re Garratt*, a rejection under 35 USC 103 is not properly made out by an unsupported statement that it is "obvious to one of ordinary skill in the art". The Examiner bears the burden of providing support for such a rejection. In view of the authorities cited above, the Examiner has not provided adequate support either for the statement of what would have been 'obvious to a person skilled in the art', contrary to the holding in *Garrett*, or to provide suggestion for the combination, as in *Levengood*. As such the applicant respectfully submits that requirements for a rejection under 35 U. S. C. 103 have not been met.

5) Application of Law to Rejections

Claim 1

Claim 1 was rejected under 25 USC 102 given US Patent 3,371,622 of Lich.

The Examiner points to Lich item 51 as being a cantilevered articulation. The applicant disagrees. Item 51 is actually identified as a pin mounted at one end of Lich's drawbar 41. The draw bar does not appear to be intended to transmit vertical shear loads, given pin 43 and pin 51, in contrast to the articulation connection claimed in claim 1. Claim 1 has been clarified in this regard.

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As such the applicant respectfully submits that claim 1, and all presently rejected claims dependent therefrom, namely claims 2 and 3, are allowable over Lich.

Claim 6

Claim 6 was rejected under 35 USC 102 on the basis of the Lich reference. Claim 6 has been amended in a manner consistent with the amendment of claim 1. As such, the applicant respectfully submits that claim 6, and those claims presently rejected depending from claim 6, namely claims 14 - 21 and 24, are also allowable over Lich.

Claim 46

Claim 46 was rejected under 35 USC 102 on the basis of the Lich reference. Claim 46 has been amended in a manner consistent with claims 1 and 6. The applicant respectfully submits that claim 46 as presently amended is allowable over Lich.

Claim 58

Claim 58 was rejected under 35 USC 102 on the basis of the Lich reference. Claim 58 has been amended in a manner consistent with claims 1, 6, and 46. As such, the applicant respectfully submits that it, and all presently rejected claims depending from it, namely claims 47 - 55 and 66 - 71, are allowable over Lich.

Claim 57

Claim 57 was rejected under 35 USC 103 as being, in the Examiner's view, obvious given Lich in light of Ehrlich et al. The applicant respectfully traverses the rejection, and seeks reconsideration thereof.

The Examiner has asserted that:

"Lich teaches all of claims 57, 59 - 61, 63 - 64, 69 - 71, 83, except for an articulated railroad freight car having a third single truck coupled to a two-truck middle unit forming a three-pack railroad [car ?] with intermediate bridge plates to allow [allow ?] vehicles to be conducted between the railcars. The general concept of providing a third single truck coupled to a railroad train consist [?] with intermediate bridge plates to allow [allow ?] vehicles to be conducted between the railcars in a railroad freight car is well known in the art as illustrated by Ehrlich et al., which discloses the use of a single truck coupled to a two-truck middle unit forming a railroad train consist

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with intermediate bridge plates to allow [allow ?] vehicles to be conducted between the railcars, see fig. 1. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lich to include the use of a third single truck coupled to a two-truck middle unit forming a three-pack railroad with intermediate bridge plates to allow [allow ?] vehicles to be conducted between the railcars in his advantageous articulated railroad freight car as taught by Ehrlich et al., in order to reduce the weight of the end unit railroad cars, provide a bridge between two adjacent railcars for transit of vehicles."

The applicant respectfully disagrees with this statement.

Preliminary Commentary

As a preliminary matter, the applicant respectfully submits that the above quoted commentary made in the office action is not supported by the references cited by the Examiner.

First, notwithstanding the title of US Patent 5,622,115, Ehrlich et al do not describe or show an articulated railroad car. They show "A novel railcar [that] includes a floor, upstanding side walls which are connected to the floor and a top. A no slack coupler is provided for coupling *adjacent railcars* together to form an articulated train. The railcar includes landing gear having a flanged wheel beneath a forward portion thereof and a bi-directional bogie mounted beneath a rearward portion thereof." (See Ehrlich et al., Abstract, emphasis added).

Ehrlich et al., show adjacent railcars (plural) not an articulated rail road car (singular) that are joined together at releasable couplings. Ehrlich et al., show "an articulated train", not an articulated rail road car.

Second, Ehrlich et al., clearly do not show a three pack articulated rail road car.

Third, Ehrlich et al., do not show a "two-truck" unit of an articulated railroad car, let alone a middle unit of a three-pack. Ehrlich et al., do show a retractable landing gear, but a retractable landing gear is not a railcar truck. In the event that this point is not immediately clear to the Examiner, he may wish to consider whether Ehrlich's rail cars could negotiate a curve, or switch onto a siding, if the landing gear were extended.

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Fourth, the statement that "the general concept of providing a third single truck coupled to a railroad train consist ... is well known in the art as illustrated by Ehrlich et al., which discloses the use of a single truck coupled to a two-truck middle unit ..." does not make sense.

The applicant respectfully submits that the phrase "... providing a third single truck coupled to a railroad train consist ..." simply does not make sense. It appears that either the word "truck" or the word "consist" is not being correctly used, or there are words missing from the sentence.

Further, the applicant flatly traverses suggestion that this is "well known". On the contrary, if the Examiner's statement were correct as it stands, the applicant suspects that such a freight car might well be considered quite a rarity. The Examiner is asked to provide support for this statement in the objective evidence of record in this case.

Further still, the applicant denies that any such thing as "a single truck coupled to a two truck middle unit" is shown in the Ehrlich illustrations. To the extent that the Examiner may not be prepared to acknowledge this, the applicant respectfully requests that the Examiner identify the specific Figure or Figures, and the item numbers in that Figure, or in those Figures, that support this statement.

For these reasons, the applicant respectfully submits that, even before considering whether the cited art has the features of the claim, the applicant submits that the commentary in the Office Action upon which the rejection is based is not supported by the cited art. To that extent, the applicant submits that the rejection is not properly made.

In the event that the Examiner proposes to sustain the current rejection, the applicant respectfully requests that the specific features of the Ehrlich et al., reference that are said to read on features of claim 57, or on the features of the other claims rejected under 35 USC 103, be identified by item number, and by column and line number in the Ehrlich et al., reference.

Inasmuch as the applicant submits that the rejection appears to be unclear, or to be missing words, the applicant respectfully requests that, if rejection is not withdrawn, but instead is revised to provide clarification or correction to permit the basis of the rejection to be understood, the applicant be provided with a full and fair, non-final opportunity in which to respond to that corrected or clarified rejection.

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No Demonstration of Motivation to Combine

In addition to these preliminary comments, turning to the three part test set out in MPEP 2142, and quoted above, even if the references had the features attributed to them in the commentary in the office action, (which, as noted above, the applicant respectfully submits they do not), it is an essential part of the test for obviousness that the Examiner demonstrate that there is a suggestion, motivation, or incentive to modify or combine the art as proposed in the office action. That suggestion, motivation, or incentive must be objectively demonstrated in the prior art of record in the case.

First, in the office action there does not appear to be any specific source of suggestion, motivation, or incentive to combine identified in the objective art of record in the case. In that light, the burden of the test of MPEP 2142 simply is not met. As such, the applicant submits that no basis for the rejection of claim 57 (and of any other claims rejected under 35 USC 103 in this case) has been established. The applicant therefore respectfully requests that the rejection of claim 57 (and of any other claim presently pending in this case) under 35 USC 103 be withdrawn, and the case be passed to allowance.

In the event that the Examiner proposes to sustain the rejection of claim 57, or of any other claim presently pending in this case under 35 USC 103, the applicant respectfully requests that the Examiner identify, with precision, the location in the objective art of record in this case at which the suggestion, motivation, or incentive to modify or combine is found, and to quote the specific wording in the reference at that location, or those locations, in which the suggestion, motivation, or incentive to modify or combine is thought to reside.

Second, even aside from the lack of support in the commentary of the office action itself, the Lich and Ehrlich et al., references refer to opposite inventions. That is, one of the alleged inventions in the Ehrlich et al., patent is a novel, releasable no-slack coupler. The invention claimed in Lich is a system that uses hooks and links to connect the cars. Lich's hooks and links are clearly not intended to be releasable in the normal course of day-to-day operation. Further, one of the ostensibly advantageous aspects of the Ehrlich et al., apparatus is that it can be adapted relatively quickly for road operation drawn by a semi-tractor rig, as indicated in Figure 1b. This capability would seem to be quite inconsistent with the apparatus shown, described and claimed by Lich.

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That being so, and since the question of suggestion, motivation or incentive to modify or combine requires that the references each be considered as a whole, the applicant submits that, if anything, the references teach away from each other. There is no apparent reason why a person skilled in the art would be led to modify or combine the references as proposed in the office action.

For all of these reasons, the applicant respectfully submits that *prima facie* grounds for rejection of the claims under 35 USC 103 have not been established. As such the applicant respectfully submits that the claims are allowable over the cited art and requests their allowance.

Claim 72

Claim 72 was rejected under 35 USC 102 on the basis of the Lich reference. Claim 72 has been amended in a manner consistent with claims 1, 6, 46 and 58. It has also been amended to replace the mixed terminology "articulated connection" with the term "articulated connector". The applicant respectfully submits that claim 72, and all claims dependent therefrom, namely claims 73 -- 82, are allowable over Lich.

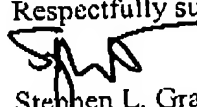
Claim 83

Claim 83 was rejected as being obvious under 35 USC 103 given Lich in view of Ehrlich et al. The applicant respectfully traverses this rejection for the same reasons as given for the traverse of the rejection of claim 57.

6) Conclusion

In view of the foregoing arguments and claim amendments the applicant submits that the claims are in a condition to permit allowance. Therefore the applicant requests early and favourable disposition of this application.

Respectfully submitted,



Stephen L. Grant
Reg. No. 33,390
Hahn Loeser + Parks LLP
1225 W. Market St.
Akron, OH 44313
slgrant@hahnlaw.com

330-864-5550
Fax 330-864-7986